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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR     | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|--------------------------|---------------------|------------------|
| 10/035,685      | 12/26/2001  | Richard William St. John | 15768 (201-0675)    | 3359             |

27378 7590 01/04/2005

MACMILLAN, SOBANSKI & TODD, LLC  
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TOLEDO, OH 43604

EXAMINER

MOHANTY, BIBHU R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3747

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/035,685

**Applicant(s)**

ST. JOHN ET AL.

**Examiner**

Bibhu Mohanty

**Art Unit**

3747

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**I. DETAILED ACTION**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-17, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Edwards et al US Patent 2,486,931.

Edwards has disclosed the invention as claimed showing a bracket body (3) with mounting projections (the holes in member 3 where the rivets are placed) for securing the device to a mounting surface (2). The bracket body (3) also has a releasable mounting means (the aligned holes in member 3) into which the prongs from the suspended element (1) are placed to hold the to the element (1) in place.

Note that the bracket members (3, 4, 3) are considered one unit or integral "body". Note that Webster's New International Dictionary (Second Edition) defines "integral" as "(2) Composed of constituent parts making a whole; composite; integrated." It has been held that the term "integral" is not necessarily restricted to a one-piece article. See *In re Kohno* (CCPA) 157 USPQ 275.

With regard to claim 17, the retaining member (4) includes ribs (5), and an interior groove to hold the component. Note that the claims are drawn only to the mounting bracket. The phrase for a "corresponding plurality of ribs and grooves on the

Art Unit: 3747

component” are not considered a limitation to the claim since the component is not positively recited.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-13, 18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards US Patent 2,486,931.

Edwards has disclosed the invention substantially as claimed (see ppgh. 1 above). However, Edwards does not disclose the bracket to hold an ignition coil assembly or to be mounted at a specific engine location.

The device of Edwards clearly displays a mounting assembly, which allows for easy removal of suspended items. It would be obvious to use the assembly to hold any desired items.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Edwards to support an ignition coil if desired for the easy removal of the suspended item. The placement of the bracket anywhere in the engine compartment is considered an obvious expedient based on the desired accessibility of the device.

3. Applicants response filed 1-28-04 has been received and fully considered. The arguments presented are not considered persuasive to withdraw the rejection of record.

Applicant argues at page 5, paragraph 2, that the "bracket of the Applicants claimed invention is not movable or adjustable". Note however that the applicant's claims contain no references to such a limitation for the bracket to "not be movable or adjustable". Here, the applicant's arguments are broader than the applicant's claims.

The applicant also argues a page 5, paragraph 2, that "the projections 5 on the adjustable mount 4 of the Edwards et al patent serve to retain the resistor but do not cooperate with apertures, tabs, or mounting means on the resistor as recited in the applicants claims". The Examiner points out the rejection of record did not refer to the projections 5 of Edwards et al as being the component which cooperated with mounting means on the element 1. The rejection of record pointed out that Edwards shows the mounting projections (3) to have the holes where the rivets are placed to fix the device to the mounting surface (2). Further, Edwards mounting projections (3) have aligned holes in them (which are unnumbered) for receiving the mounting projection from each end of the cylinder element (1).

Applicant's arguments that it would not have been obvious to move the bracket to another location in the engine have also been considered but are not deemed persuasive. It would have been obvious to move the mounting portion to any desired location for the reasons noted in the rejection above.

Art Unit: 3747

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

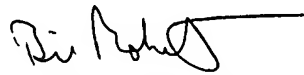
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bibhu Mohanty whose telephone number is 571 272-4851. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Yuen can be reached on 703 272-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3747

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bibhu Mohanty  
Primary Examiner  
Art Unit 3747

brm